

REMARKS

Claims 1, 3-6, 8-12, 14 and 16-22 are now pending in the application. Minor amendments have been made to the specification to overcome the rejections of the claims under 35 U.S.C. § 112. The amendments to the specification are supported by the drawings as originally filed, and therefore do not constitute new matter. The Examiner is respectfully requested to reconsider and withdraw the rejection(s) in view of the amendments and remarks contained herein.

REJECTION UNDER 35 U.S.C. § 112

Claims 1, 3-6, 8-12, 14 and 16-22 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. This rejection is respectfully traversed.

Applicants note that the specification has been amended to include a more detailed description of the originally filed drawings. Applicants note that drawings are sufficient to satisfy the written description requirement. Vas-Cath, Inc. v. Mahurkar, 935 F.2d 1555. Specifically, the court in Vas-Cath noted that “the proper test is whether the drawings conveyed with reasonable clarity to those of ordinary skill that Mahurkar had in fact invented the catheter recited in those claims.” Vas-Cath at 1566. The court concluded that “[c]onsideration of what the drawings conveyed to persons of ordinary skill is essential.” Id. In the present application, the drawings clearly support the content of the language added to the specification and previously presented claims.

Specifically, Figure 1 clearly shows the position of metering device (34) as being between water separator (24) and suction inlet (26). More specifically, there is no

feedback from a sensor, or any other input from suction inlet (26) that would impact the control of metering device (34) by controller (40). In view of Figure 1, one skilled in the art would recognize that the “metering device [is] adapted to regulate said cathode exhaust gas independently from said fresh gas” as required by claim 1. Therefore, in view of the precedent cited above and the disclosure shown in the drawings as originally filed, there is support in the drawings to satisfy the requirements of 35 U.S.C. §112 first paragraph. As such, the previous amendments to the claims and the currently amended specification do not include new matter since they are clearly supported by the drawings as originally filed.

In view of the amendments to the specification and the drawings as originally filed, Applicants submit that there is support for the previous amendment to the claims. Therefore, reconsideration and withdrawal of the rejection of claims 1, 3-6, 8-12, 14 and 16-22 are respectfully requested.

REJECTION UNDER 35 U.S.C. § 103

Claims 1, 3-6, 8-12, 14 and 16-22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Benz et al. (U.S. Pat. No. 5,645,950, hereinafter “Benz”) in view of Scheffler et al. (U.S. Pat. No. 4,859,545, hereinafter “Scheffler”). This rejection is respectfully traversed.

At the outset, Applicants note that the rejection under §112 is believed to have been overcome. As such, the Examiner must consider the limitations present in the previously presented claims. Specifically, the independent control of the cathode exhaust gas relative to other gases required by independent claims 1, 8, 14, and 20 is not present in either of the references cited by the Examiner, as discussed in the

previous response. Claims 3-6, 9-12, 16-19, 21, and 22 depend from claims 1, 8, 14, and 20. Therefore, reconsideration and withdrawal of the rejection of claims 1, 3-6, 8-12, 14 and 16-22 are respectfully requested.

Applicants additionally believe the claims to be in condition for allowance due to the failure of the references cited by the Examiner to disclose control of the flow feedback gas to adjust humidity. The Examiner merely concludes “[t]he Benz et al. combination would obviously provide the claimed controller that controls the metering device, the injector and the compressor to adjust the humidity” without providing any support for this modification. In response to Applicant’s previous arguments regarding improper hindsight for this rejection, the Examiner cites In re McLaughlin, 443 F.2d 1392, stating that hindsight is allowable “so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant’s disclosure, such a reconstruction is proper.” Applicants respectfully disagree with the Examiner’s application of McLaughlin to the present action.

In McLaughlin, the court stated that “[t]he test for combining references is not what the individual references themselves suggest but rather what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art.” McLaughlin at 1395. The court went on to analyze the content of the references cited by the Examiner, stating the “Cook patent does indicate that the car shown therein is suitable for carrying palletized loads.” Id. The court concluded that “since the secondary references show that it was well known to use side filler panels ... we agree that those references would have suggested use of such panels and bulkheads with the

Cook car for the same purpose.” Id. The court nowhere suggests that content not found in any of the cited references can be introduced without being considered impermissible hindsight.

In the present action, neither of the references cited by the Examiner suggests control of cathode exhaust feedback based on humidity. The Examiner has merely concluded that this is obvious without any support for the proposition. Applicants submit that if this control based on humidity is obvious there would be a reference indicating such, as the Benz patent issued in 1997 and the Scheffler patent issued in 1989. Applicants respectfully remind the Examiner that it is clearly established that “[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.” In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992)(citing In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984)). As there is no suggestion of the desirability of the modification in the references, Applicants submit that the limitations of claims 1, 8, 14, and 20 are simply not taught or suggested by the proposed combination.

Therefore, Applicants submit that claims 1, 8, 14, and 20 are in condition for allowance. Claims 3-6, 9-12, 16-19 and 21-22 depend from claims 1, 8, 14, and 20, respectively, and should be in condition for allowance for the reasons set forth above. Therefore, reconsideration and withdrawal of the rejection of claims 1, 3-6, 8-12, 14, and 16-22 are respectfully requested.

CONCLUSION

It is believed that all of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider and withdraw all presently outstanding rejections. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance. Thus, prompt and favorable consideration of this amendment is respectfully requested. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (248) 641-1600.

Respectfully submitted,

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